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10/692,031	10/23/2003	William F. Crismore	007404-000571 19032 US5	5358
41577	7590	03/19/2010	EXAMINER	
WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP 111 MONUMENT CIRCLE, SUITE 3700 INDIANAPOLIS, IN 46204-5137			ALEXANDER, LYLE	
			ART UNIT	PAPER NUMBER
			1797	
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			03/19/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/692,031  
Filing Date: October 23, 2003  
Appellant(s): CRISMORE ET AL.

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Elizabeth Shuster  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/8/10 appealing from the Office action mailed 3/9/09.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The Double Patenting Rejections and all of the 35 USC 102 rejections.

**NEW GROUND(S) OF REJECTION**

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

Claims 68-104 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath is set forth in the discussion below in this Office action.

Claims 68-104 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The original specification, as described in USP 5,997,817, does not teach a "fill line" to determine addition of the proper amount of sample.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

5,997,817	Crismore et al.	12-1999
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#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 68-104 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification, as described in USP 5,997,817, does not teach a “fill line” to determine addition of the proper amount of sample.

Claims 68-104 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath is set forth in the discussion below in this Office action.

Claims 68-104 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The original specification, as described in USP 5,997,817, does not teach a “fill line” to determine addition of the proper amount of sample.

#### **(10) Response to Argument**

Appellants’ arguments with respect to the Double Patenting and 35 USC 102 rejections were convincing and these rejections have been vacated.

The remaining issues are the propriety of the 35 USC 112 1<sup>st</sup> paragraph new matter rejections, the new 35 USC 251 rejections that directly corresponds to the new matter rejections and the formality of providing a proper oath.

Appellant states on page 21 of the 12/8/09 Brief (referenced hereafter as “the Brief”) the original disclosure does not have to provide “*in haec verba* or exact language

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support for the claimed subject matter at issue.” Appellants quote excerpts from the original specification on pages 22-23 of the Brief they believe support the contested language “a fill line”. The Office notes the common features of these excerpts are “... a transparent or translucent window which operates as a ‘fill to here’ line ...” and “... roof 13 includes transparent or translucent window 18 ...”. The Office has read these excerpts and the original specification as teaching the test strip has a transparent cover. These cited excerpts and the original specification do not teach or suggest placement of an actual “fill line” as presently claimed. The Office maintains the 35 USC 112 1<sup>st</sup> paragraph rejections and the 35 USC 251 rejections are proper.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

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41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/LYLE A ALEXANDER/  
Primary Examiner, Art Unit 1797

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/Tom Dunn/  
Quality Assurance Specialist, TC 1700

Conferees:

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/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797

/Tom Dunn/  
Quality Assurance Specialist, TC 1700